

5/23/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 10
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beckett Corp.

Serial No. 75/832,074

Lisa Shareeen Zamaludin of Gardere Wynne Sewell LLP for
Beckett Corporation.

Daniel S. Brody, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 26, 1999, applicant filed the above-referenced application to register the mark "FLOWER BED FOUNTAIN" on the Principal Register for "decorative water fountains comprising an underground basin, tubing and pump." The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive of the goods set forth in the application.

Submitted in support of the refusal to register were excerpts from articles retrieved from the Nexis database of published articles which illustrate that fountains are often used in gardens in conjunction with flower beds. For example, the March 9, 2000 edition of The Colombian (Vancouver, Washington), in discussing designs prepared for a community square, noted that each design had "flower beds, a bell tower and a fountain shooting pulsating jets of water into the air." The February 28, 2000 edition of The Chicago Tribune stated that "a new park proposed for downtown Arlington Heights will feature a fountain, flower beds and an elevated stage that could be used for performances." The September 25, 1999 the edition of The Washington Post stated that "an indispensable feature of such a Truscan garden is a central pool containing a stone statue fountain. Around it are four symmetrical flower beds..." The August 29, 1999 edition of The Orange County Register includes a description of a garden wherein "flower beds surround a fountain and statues." The August 25, 1999

edition of The Times-Picayune includes this sentence:

"Anyway, last Saturday Rock and I toiled for hours installing a fountain in the flower bed near the patio." The July 9, 1999 edition of The Spokane Spokesman-Review commented that "... the hole has become a fountain and raised flower beds, thanks to a lot of hard work." The June 10, 1999 edition of The Tennessean describes "... the winding path leading from a formal fountain encircled with flower beds through shrubs and under trees into a rocky, shaded pool." The May 7, 1999 edition of The New York Times describes a garden as "formally arranged in the classical French style, with two circular flower beds surrounding a large fountain..."

Applicant responded to the refusal to register with argument that its mark is not merely descriptive of the goods specified the application. Applicant contended that although the mark "may suggest to consumers that applicant's fountains may be placed in flower beds, as the submitted specimen establishes,¹ the fountains do not have to be used in flower beds." Thus, applicant argued, the mark is not merely descriptive.

¹ This is a curious statement in view of the fact that the application, as noted above, is based on applicant's assertion of the intention to use the mark in commerce, rather than upon actual use. No specimen of use was submitted in connection with this application.

In addition to arguing against the refusal to register, applicant amended the application to disclaim the descriptive word "FOUNTAIN" apart from the mark as shown.

In the second Office Action, the Examining Attorney made final the refusal to register under Section 2(e)(1) of the Act. Additional evidence was submitted in support of the refusal. Copies of pages from a search of the Internet were submitted to show that fountains are used in flower beds. "The Intimate Gardener" promotes fountains as "garden accents." One such advertisement shows a "Brass Toad Fountain" which is shaped like a toad. The advertisement states that "this cute little toad can hide in your flowerbed or planter." Many other fountains, apparently designed for use in gardens, are displayed in this catalog.

Also submitted with the final refusal to register was a copy of an article taken from the Internet concerning a park with a fountain in a flower bed, but the park appears to be in Moosejaw, which is apparently in Canada, and we have no way of knowing whether any appreciable number of people in the United States have been exposed to either the article or to actually seeing this fountain in Moosejaw. Thus, this evidence is of little probative value.

Applicant timely filed a Notice of Appeal from the refusal to register, and subsequently submitted an appeal brief. The Examining Attorney filed his brief on appeal,² and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

The test for determining whether a mark is merely descriptive within the meaning of the Lanham Act is well settled. A mark is merely descriptive under Section 2(e)(1) of the Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods. In *re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In *re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive of them; rather, it is sufficient if the term describes any significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being

² Submitted with this brief were dictionary definitions (of which we can take judicial notice), of "flower bed" and "fountain," although applicant does not appear to contest the meanings of these terms.

used in (or is intended to be used) in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multistage reasoning process or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. In *re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984). The question is not whether someone presented with only the mark could correctly speculate as to what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

Based on careful consideration of the written record in this application and the arguments of applicant and the Examining Attorney in light of the relevant legal authority, we hold that the Examining Attorney has met his burden of establishing that the term applicant seeks to

register is merely descriptive of the goods with which applicant intends to use it.

As applicant admitted in its response to the first Office Action, the fountains with which it intends to use the mark may be placed in flower beds. This is a significant purpose, use or function of decorative water fountains, and the market immediately and forthwith conveys this information about these products. Under these circumstances, Section 2(e)(1) of the Act precludes registration of the term.

Applicant's argument that its fountains do not have to be used in flower beds is not persuasive of a different holding in this case. That applicant's fountains may be used in the manner indicated by the mark is a significant feature or characteristic of the goods. That they have other features or uses that the mark does not describe does not make the term sought to be registered any less descriptive of the characteristic which it does identify.

Applicant submitted with its brief copies of a third-party registration of the mark "FLOWER BED" for housewares and glass goods, namely, flowerpots and drain dishes for flower pots, as well as copies of information concerning three third-party applications for marks which also include this term. Although this evidence was not properly made of

record in accordance with Trademark Rule 2.142(d), the Examining Attorney nonetheless addressed it, so we have considered this evidence. As the Examining Attorney points out, however, only one trademark registration is cited by applicant; there is no evidence that this mark is in actual use; and the goods identified therein are unrelated to the products specified in the instant application. Thus, the existence of this registration is of little probative value.

In the same sense, applicant's argument that this descriptive term should be registered because there are other meanings for the words which make up the mark that do not apparently relate to decorative water fountains is not well taken. As noted above, the descriptiveness of a term within the meaning of the Act is not determined in a vacuum, but rather in relation to the goods identified in the application. Our inquiry therefore must be whether someone who knows that the goods are decorative water fountains will be further informed as to their features, uses or characteristics by this mark. Consumers presented with applicant's products bearing the mark "FLOWER BED FOUNTAIN" will immediately know, without further thought or imagination, that applicant's goods are fountains that may be used in flower beds. As such, the term is merely

Ser No. 75/832,074

descriptive and registration is precluded by Section
2(e)(1).

DECISION: The refusal to register is affirmed.